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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the

BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of Gerhard J. Haas

Serial No. 10/046,897

Filed: Jan. 17, 2002

Appeal No.

Art Unit 1651

Examiner Susan D. Coe

For: Hop-Based Udder and Teat Dips and Washes

APPELLANT'S BRIEF

Appellant, Gerhard J. Haas, respectfully submits this Appellant's Brief in triplicate in accordance with 37 C.F.R. §1.192. It is accompanied by a petition for a one-month extension of time to file this brief, which was initially due to be filed by April 19, 2004.

In accordance with 37 C.F.R. 1.192(c), the following items are set forth under the appropriate headings and in the order indicated by the Rule.

(1) *Real party in interest.* The real party in interest is S. S. Steiner, Inc., 655 Madison Avenue, New York, N.Y.

(2) *Related appeals and interferences.* There are no other appeals or interferences known to appellant, appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) *Status of claims.* The claims on appeal are claims 1 to 8, inclusive. While the application was filed with claims 1 to 14, after a requirement for restriction, which was

traversed, the invention of claims 1 to 8 was elected for prosecution on the merits. Claims 1 to 8 are pending; no claim has been allowed.

(4) *Status of amendments.* No amendments have been filed subsequent to final rejection.

(5) *Summary of invention.* The present invention is a method for sanitizing the udders and teats of dairy cows by washing or dipping those udders and teats in a solution an active ingredient of which is a hop compound in an effective concentration.

(6) *Issues.* The basic issue concerns the disclosure and scope of Japanese Application 01172332 A. That reference is the essential element of all of the bases of rejection. Those bases are whether claims 1 to 8 are obvious in view of JP '332 *per se*, (rejection no. 1), or U.S. Patent No. 4,170,638 in view of the Japanese application, (rejection no. 2), or U.S. Patent No. 5,370,863 in view of the Japanese application, (rejection no. 3). Thus, all three of the rejections have as their controlling element the disclosure of the Japanese application.

(7) *Grouping of claims.* For the purposes of this appeal only, and without prejudice to a claim to the contrary in litigation, all of claims 1 to 8 comprise a single group.

(8) *Argument.*

A. Japanese Patent Appln. 01172332A Neither Anticipates The Claimed Invention Nor Renders It Obvious.

1. The Reference Does Not Disclose Washing or Dipping.

While claims 1 to 8 have been rejected under Section 102 and, in the final rejection mailed April 8, 2003, under Section 103, neither basis of rejection is proper because this

art-blocking application¹ in its sweeping disclosure fails to disclose this most simple of inventions: washing or dipping the teats and udders of cows to kill pathogens on them.

To pinpoint the controversy here, on page 2 of a Supplement to Advisory Action, mailed 11/19/2003, after listing applicant's arguments, the Examiner says:

"However, these arguments are not persuasive because on page 14, second full paragraph,² the reference states that the active ingredients can be administered transdermally. This shows that the reference clearly envisioned administering the active ingredients through the skin of the animal. Therefore, the reference is still considered to provide motivation for administering hops directly to the udders to treat mastitis."

What the Examiner finds so convincing is this paragraph: The method of giving it is either oral or non-oral administration. As non-oral administration, intramuscular, intra stomach, transdermal, nasal and vein administration can be used."

The word, transdermal, admits the Examiner, does not disclose washing or dipping. However, says the Examiner, it "provide[s] motivation for administering hops directly to the udders to treat mastitis."

First, in so stating the Examiner is constructing his own claim; the language used by her is simply not that claimed. Claim 1 claims washing or dipping, not the amorphous term, administering. Moreover, it does not claim that the purpose is to treat mastitis but to kill pathogens. The weakness of the rejection is magnified by the fact that the Examiner is constructing his own claim rather than recognizing the words of

¹ If the Board will examine the full and complete translation of this application which, of course, never issued as a patent, it will see that so many different plants are said to be effective treatments for bovine mastitis that it is almost easier to define what plants are not claimed to be effective.

² For the convenience of the Board, page 14 of the translation is attached as Exhibit A. The pages were not individually numbered.

applicant's claim. The patentability of the Examiner's straw-man is irrelevant here.

Clearly the paragraph on which the Examiner relies does not disclose washing or dipping. This is not the first time during prosecution that the meaning of the term, transdermal, has arisen.³ Indeed, applicant previously had a certified translation made of that paragraph, alone, with emphasis on the word, transdermal. A copy of that certified, one-page translation is annexed as Exhibit B. Focusing on the term in issue the translator said, "The word, transdermal, is used interchangeably with transcutaneous. It means "through the skin." Examples of transdermal administration would be by syringe injection or the use of a medicated patch."

How does one jump from a disclosure of a syringe injection of a substance to washing or dipping with a solution of the substance? Obviously there is no disclosure here that would form the basis for a Section 102 rejection. What is the motivation for washing or dipping when one is informed of a syringe injection or medicated patch? The Examiner has said there is motivation (for her own misstated claim), but merely said the words rather than explain why the motivation would arise. Motivation is surely required. Why one would be so motivated is a mystery.

2. The Examiner Has Disregarded the Reference as a Whole.

It is a certitude that a reference must be considered as a whole. See 2 *Chisum on Patents*, Matthew Bender & Co., Inc. 2003, §5.03[3][a][i]. One should not "...pick and choose from any one reference only so much of it as will support a given position, to the

³ Despite the fact that the paragraph in issue was separately translated, the Examiner demanded a certified translation of the entire patent. Apparently not finding anything in that translation to bolster his position, he returned to the same paragraph previously translated and did not mention the remainder of the translation. This caused applicant to incur an unneeded expense of almost \$1000 in translation fees.

exclusion of other parts necessary to the full appreciation of what such reference fully suggests to one of ordinary skill in the art.” *In re Weslan*, 353 F.2d at 2412 (CCPA 1965). As more recently stated in *Bausch & Lomb, Inc. v. Barnes/Hind*, 706 F.2d 443 (Fed. Cir. 1986), a single line in a reference should not be taken out of context with the benefit of hindsight to show obviousness. The reference must be viewed as a whole.

3. Viewing the Reference As a Whole, It Teaches Away from Applicant’s Invention

There are numerous decisions that recognize that an invention which might otherwise be viewed as an obvious modification of the prior art will not be deemed obvious in a patent law sense where one or more prior art references ‘teach away’ from the invention. *Chisum, supra*, at §5.02[3][a][i][G]. Thus, in *Singh v. Brake*, 317 F.3d 1134, 1346, 65 USPQ2d 1641 (Fed. Cir. 2003) the Federal Circuit said: “Whether or not a reference ‘teaches away’ from a claimed invention is relevant in determining whether or not a claimed invention would have been obvious.”

In *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1354, 60 USPQ2d 1001 (Fed. Cir. 2001) the Court repeated that “...references that teach away cannot serve to create a *prima facie* case of obviousness.” The same thought is contained in *In re Peterson*, 315 F.3d 1325, 1331, 65 USPQ3d 1379 (Fed. Cir. 2003): “An applicant may rebut a *prima facie* case of obviousness by showing that the prior art teaches away from the claimed invention in any material respect.”

Not only does the prior art teach away from the claimed invention --washing or dipping the udders of cattle-- but the reference on which the Examiner stakes his entire position teaches away. If the Board will refer to Exhibit A, page 14 of the Japanese translation, it will see that the paragraph immediately preceding that in which the word,

transdermal, is used states as follows:

The amount to be administered varies in a range from about 0.001 mg/body weight kg/day ~ 100g/body weight kg/day in the original weight of galenicals. An amount of an agent for prevention is different from that of the agent for treatment, and generally the amount to be administered is larger for the latter.

So, what the Japanese Application tells us about dosage is that it is based on the body weight of the cow to be treated. This is consistent with putting the vegetation in cattle feed, or even for administering it to the animal by hypodermic syringe. It is certainly not consistent with any interpretation of the reference that might lead one to put the vegetation in a solution and wash the udders of a cow with it. Indubitably there is no connection between the body weight of the cow and the concentration of hops in a solution used to wash the udders of the animal.

By correlating body weight of the animal to the concentration of the vegetable, or galenical, the application teaches away from any possible interpretation that might lead one to use a solution of the vegetable as a wash or dip for the animal.

**B. The Rejections Based on a Combination of References
Do Not Render the Claims Obvious.**

1. U.S. Patent No. 3,170,638 and the Japanese Application.

The claims have also been rejected on a hypothetical combination of this patent and the Japanese Application. As the Examiner stated in the final rejection mailed April 8, 2003, page 3, "...JP '332 is considered to provide motivation to use a hops composition as a wash or dip in treating infections...." Yet since the Japanese Application *per se* does not provide such motivation and, indeed, teaches away from the use of a hops composition in a wash or dip, no combination with another reference that does not so teach will result in the claimed invention...unless the other reference teaches the use of a wash containing hops.

The '638 patent does not supply the missing link. Instead, it discloses the use of a hops extract in preparing a deodorant for humans to inhibit the growth of *S. aureus*. Deodorants are submitted to be a non-analogous art. Moreover, any theoretical combination would result in a deodorant for cows or injecting humans with a hop material, both distasteful to imagine.

2. U.S. Patent No. 5,370,863 and the Japanese Application.

Here the primary reference teaches the use of hop acids in dentifrices. It states at col. 1, lines 53 to 56: "The novel oral care compositions of the present invention are toothpastes, tooth powders, mouthwashes, gums⁴ and the like which are formulated for administration to the oral cavity." So, once again the art of the primary reference is non-analogous, *i.e.*, one seeking to treat cattle would not look to the dentifrice art, except by pure hindsight. While the dentifrices of this U.S. patent do contain hop acids, once again the combination of its disclosure and that of the Japanese application would result in a dentifrice for cattle or injecting humans with a hop acid.

In the manner of formulating the final rejection of this combination with the prior combination, the Examiner states:⁵ "...JP '332 is considered to provide motivation to use a hops composition as a wash or dip in treating infections...." As JP '332 does not provide that motivation because it teaches away from the claimed invention, both combination rejections under §103 must fail.

D. Conclusion Regarding Patentability.

Regardless of the form in which the art rejection is framed, it all comes down to

⁴ This really does not appear to make sense, but that is what the references says.

⁵ Action mailed April 8, 2003, page 3, last two lines.

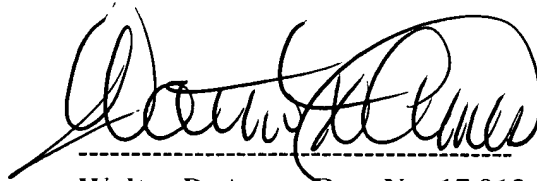
whether the Japanese Application discloses washing the udders of cows with a hops solution, which it manifestly does not, or whether it would motivate one of skill in the art to do so, which is the Examiner's position. It is respectfully submitted that no logical basis for that stretch has been stated, particularly since the reference as a whole teaches away from washing udders because it bases concentrations of hop compositions on the weight of the cow, a position incongruous with determining the concentration of a wash solution. What the Examiner has done is to take one word, transdermal, from an obscure Japanese patent application and, in disregard of the remainder of the reference, use it as motivation for washing or dipping the udders of cattle. That practice is improper on the bases of logic and the law. *See, e.g., Bausch & Lomb, Inc. v. Barnes/Hind*, 706 F.2d 443 (Fed. Cir. 1986).

(9) Appendix.

Claims 1 to 8 on appeal are recited in the attached Appendix.

WHEREFORE, applicant respectfully requests that the decision of the Primary Examiner finally rejecting claims 1 to 8 of the present application be reversed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Walter D. Ames', written over a horizontal dashed line.

Walter D. Ames, Reg. No. 17,913
Attorney for Appellant

Dated: May 18, 2004

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APPENDIX

1. A method of sanitizing the udders and teats of dairy cows, comprising washing or dipping said udders and teats with an aqueous solution an active ingredient of which is a hop compound in a concentration effective to kill pathogens on said udders and teats without causing trauma to said cows.

2. A method as claimed in claim 1, in which said pathogen is a susceptible bacterium.

3. A method as claimed in claim 1, in which said hop compound is lupulone.

4. A method as claimed in claim 1, in which said hop compound is

5. A method as claimed in claim 1, in which said hop compound is the iso form of humulone.

6. A method as claimed in claim 1, in which said hop compound is selected from the group consisting of hydrogenated iso forms of lupulone and humulone and combinations thereof..

7. A method as claimed in claim 6, in which said hop compound is tetrahydroisohumulone.

8. A method as claimed in claim 1, in which said hop compound is xanthohumol.

solvents to leave. The residues are employed as effective fractions, in other words effective constituents. These effective fractions are different from the effective fractions which are previously described in physical and chemical properties and the constituents which can be detected are also different.

The amount to be administered varies in a range from 0.001 mg/body weight kg/day ~ 100 g/body weight kg/day in the original weight of galenicals. An amount of an agent for prevention is different from that of the agent for treatment, and generally the amount to be administered is larger for the latter.

The method of giving it is either oral or non-oral administration. As non-oral administration, intramuscular, intra stomach, transdermal, nasal and vein administration can be used.

[Advantages of the Invention]

As stated above in detail, the present invention provides effective agents and methods to prevent and treat bovine mastitis caused by staphylococci.

The prevention and treatment agents according to the present invention employ galenicals or extracts derived therefrom as the major agent constituents. Thus, there is no problem at all, such as appearance of resistant bacteria and side effects, which are issues with antibiotics. The agents can be administered without concerns.

Moreover, there is no need to be concerned over the adverse effects of residual agents on the human body, and therefore it is appropriate to administer the agents to cows for meat consumption to prevent and treat bovine mastitis caused by staphylococci.

Furthermore, the same disease can be prevented and treated at much cheaper costs than those when antibiotics and so forth are employed.

Further explanation of the present invention is offered below using Test Examples and Examples.

EXHIBIT

A

OHASHI HIGH TECHNOLOGY CORPORATION

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TRANSLATION CERTIFICATE

I, Takeo Ohashi, President, Ohashi High Technology Corporation, the Empire State Building, 350 Fifth Avenue, Suite 607, New York, NY 10118-6399, hereby declare that I have competent knowledge of the Japanese and English languages, and that I have reviewed the translation herein below of a paragraph on the tenth to twelfth lines of the upper right quadrant on page 5 of Japanese Laid-Open Patent Application Publication No. H1-172332 by Kenji Shibata, et. Al, as well as the translator's note herein below. I certify that the translation is an accurate representation of the aforementioned paragraph and that the translator's note is unbiased and accurate.

Translated Paragraph:

"The method of giving it is either oral or non-oral administration. As non-oral administration, intramuscular, intra stomach, transdermal, nasal and vein administration can be used."

Translator's note:

The word, transdermal, is used Interchangeably with transcutaneous. It means "through the skin" Examples of transdermal administration would be by syringe injection or the use of a medicated patch.

I declare under penalty of perjury that the foregoing is true and correct.

Executed on July 1, 2003.

CERTIFIED by said Takeo Ohashi.

at 350 Fifth Avenue, Suite 607, New York, NY 10118

this 1st of July, 2003.

A handwritten signature in cursive script, appearing to read "Takeo Ohashi".

Takeo Ohashi, Ph.D.
President

EXHIBIT

B



CERTIFICATE OF MAILING

It is hereby certified that on the 18th day of May, 2004 the foregoing Appellant's Brief and Petition for One-Month Extension of Time to file same and fees were deposited with the United States Postal Service as first-class, postage-prepaid mail in an envelope addressed to:

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313 - 1450

A handwritten signature in black ink, appearing to read "Walter D. Ames".

Walter D. Ames, Reg. No. 17,913

Attorney for Applicant